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PATENT
Attorney Docket No.: 020375-008900US

TOWNSEND and TOWNSEND and CREW LLP

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Philip T. Mellinger, *et al.*

Application No.: 10/091,001

Filed: March 4, 2002

For: CREDIT CARD TRANSACTION
TRACKING SYSTEMS AND METHODS

Customer No.: 20350

Confirmation No.: 6755

Examiner: Frantzy Poinvil

Art Unit: 3628

**APPELLANTS' REPLY BRIEF
UNDER 37 C.F.R. § 41.41**

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed June 15, 2006. The following remarks are intended to further focus the issues in this appeal.

1. Status Of Claims

Claims 1-47 are currently pending in the application. All pending claims stand finally rejected pursuant to a Final Office Action mailed April 7, 2003 and an Advisory Action mailed June 23, 2003.

The rejections of claims 1-47 are believed to be improper and are the subject of this appeal.

2. Related Appeals And Interfaces

The Examiner states that the Appeal Brief filed on September 5, 2003 does not contain a statement identifying the related appeals and interferences. Applicants state that no other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

2. Grounds Of Rejection Presented For Review

Whether claims 1-47 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao, *et al.* (U.S. Patent No. 5,903,830).

3. Response To Examiner's Argument

In the Examiner's Answer, the prior rejections were maintained and additional comments were presented in response to the Appeal Brief filed September 5, 2003. Appellants stand on the arguments presented in the Appeal Brief and present the following comments directed to the Examiner's Answer.

For the purpose of more clearly focusing the issues for appeal, the Appellants provide herein a summary discussion of the independent claims only and respectfully direct the Board to prior arguments presented in the Appellants' appeal brief for discussion of the dependent claims. The Appellants believe, however, that all pending independent claims are allowable, since a *prima facie* case of obviousness has not been presented for any independent

claim. The dependent claims are, therefore, believed to be allowable as depending from allowable independent claims and for the additional reasons stated in the Appellants' Appeal Brief.

The Appellants appreciate that the Board is fully aware of the three-prong test for *prima facie* obviousness and, therefore, do not restate that test here. The prior art of record is deficient with respect to satisfying that test for at least one prong, and in most cases two prongs, for each independent claim.

Claim 1, for example, does not satisfy prong 3 of the test for *prima facie* obviousness. Claim 1 includes "periodically receiving ... a target account identifier of a suspect account ... comparing the target account identifier with ... transaction information as the financial transaction information is received at the computer system to determine if the target account identifier matches any of the account identifiers of the transaction information; upon the occurrence of a match, generating an alert having at least a portion of the transaction record that has an account identifier matching the target account identifier; and transmitting the alert to a recipient." Joao does not teach or suggest anything having to do with receiving a target account identifier of a suspect account nor the other limitations of claim 1 relating to what is done with the target account identifier. The "Response to Argument" section of the Examiner's Answer, referencing newly-cited passages of Joao, states that Joao teaches these limitations (Examiner's Answer, pp. 11-12). But at the newly-cited location, Joao also fails to teach "receiving ... a target account identifier of a suspect account", "comparing the target account identifier" with transaction information, and "upon the occurrence of a match, generating an alert." Joao appears to teach performing standard checks to determine if a credit card has been lost or stolen, among other things, but this is different than what the Appellants claim. Hence, claim 1 is believed to be allowable, at least for this reason. Moreover, claims 2-12 depend from claim 1 and further distinguish the Appellants' claimed invention from the teachings of Joao as discussed in greater detail in the Appellants' Appeal Brief.

The Final Office Action also fails to establish a *prima facie* case of obviousness because the first prong of the three-prong test is not satisfied, and the Examiner's Answer does

not cure the deficiency. The Final Office Action appears to assert that one would have been motivated to modify Joao to achieve the Appellants' claims invention "so as to compare the financial transactions of a plurality of the associated account identifiers of which are different from the target account identifiers." Aside from the fact that the Appellants are not able to fully understand the meaning of this alleged motivation it appears to be based on the personal knowledge of the Examiner. The Appellants have repeatedly requested documentary support that this motivation existed in the prior art. As the Board is aware, when a necessary element of a claim rejection is based on the personal knowledge of a member of the Office, the Appellants are entitled to documentary evidence or an affidavit. This has not been provided, thus rendering the motivation inadequate to support a *prima facie* case of obviousness.

The Appellants recognize the possibility that the Examiner's Answer may be attempting to establish a new ground for rejection by now stating that, contrary to the Final Office Action, Joao in fact teaches all the elements of claim 1, in which case, claim 1 may be rejected under 35 U.S.C. §102. This also may be the case with other independent claims. The Appellants believe this is incorrect as stated above, since Joao does not teach all the limitations of claim 1, either expressly or inherently, as required for a proper rejection under 35 U.S.C. §102. But if the Board adopts this position, the Appellants respectfully point out that a *prima facie* case of obviousness would still fail to exist for the claims that depend from claim 1, since each limitation of each dependent claim would have to be taught by Joao and a proper motivation would have to be provided for modifying the reference *for each missing limitation*. Also of importance, in the event a new grounds for rejection is provided, prosecution should be reopened. The Appellants believe, however, that these points are moot, since the Appellants believe all pending claims are allowable over the cited reference under all standards of patentability.

Claim 13 recites "at a processing server, periodically receiving a list having a plurality of target account identifiers; periodically transmitting at least a portion of the list to one or more platform servers, ...wherein the one or more platform servers are configured to search the transaction information as the transaction information is received at the one or more platform

servers for transaction records having a target account identifier from the list; at the processing server, receiving from one of the platform servers an alert that the platform server has identified a transaction record having one of the target account identifiers...and transmitting from the processing server a notification based on the alert that the target account identifier has been identified in a transaction record." The Examiner's Answer appears to rely heavily on the comments discussed above with respect to claim 1, even though the limitations of claim 13 are different -- and in some respects narrower -- than the limitations discussed above with respect to claim 1. Hence, the Appellants also believe claim 13 is allowable, since a *prima facie* case of obviousness has not been established based on the third prong of the test. Claims 14-27 depend from claim 13 and further distinguish the Appellants' claimed invention from the teachings of Joao as discussed in greater detail in the Appellants' Appeal Brief.

Claim 28 includes limitations similar to those discussed above with respect to claims 1 and 13 that are not taught or suggested by Joao. Claim 28 is, therefore, believed to be allowable for the reasons stated above with respect to claims 1 and 13.

Claim 31 recites a system for monitoring financial transactions. It also includes limitations not taught or suggested by Joao, thus being allowable, since a *prima facie* case of obviousness has not been established. The limitations of claim 31 are similar to those discussed above with respect to claims 13 and 28, and claim 31 is believed to be allowable for similar reasons. Claims 32-44 depend from claim 31 and further distinguish the Appellants' claimed invention from the teachings of Joao as discussed in greater detail in the Appellants' Appeal Brief.

Claims 45 and 47 both recite systems for monitoring financial transaction and include limitations similar to those discussed above with respect to claims 13 and 28. Hence, claims 45 and 47 are believed to be allowable since a *prima facie* case of obviousness has not been established. Claim 46 is believed to be allowable as being dependent from an allowable base claim.

In view of the foregoing, the Appellants believe all pending claims are allowable and urge the Board to advance this application to allowance.

Respectfully submitted,

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